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BOURQUE & ASSOCIATES
INTELLECTUAL PROPERTY ATTORNEYS, P.A.
835 HANOVER STREET
SUITE 301
MANCHESTER NH 03104

MAILED

DEC 09 2010

OFFICE OF PETITIONS

In re Patent No. 6,265,983 :
Issue Date: 07/24/2001 :
Application Number: 09/408,798 : DECISION ON PETITION
Filing Date: 09/30/1999 :
Attorney Docket Number: :
BAILLAR-001A

This is a decision in reference to the petition, filed on December 22, 2009, under 37 CFR 1.378(c), to accept the unintentionally delayed payment of the first and second maintenance fees for the above-identified patent. This is also a decision in reference to the petition, filed on June 22, 2010, under 37 CFR 1.378(b), to accept the unavoidably delayed payment of the first and second maintenance fees for the above-identified patent.

The petitions are **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(h). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued on July 24, 2001. The first maintenance fee could have been paid from July 24, 2004, through January 24,

2005, or, with a surcharge during the period from January 25, 2005 through July 24, 2005. Accordingly, the patent expired at midnight July 24, 2005, for failure to timely submit the first maintenance fee.

PETITION UNDER 37 CFR 1.378(c)

37 CFR 1.378(c) provides that a petition to accept an unintentionally delayed payment of a maintenance fee must be filed within twenty-four months of the six-month grace period provided in § 1.362(e) and must include:

- (1) The required maintenance fee set forth in § 1.20(e) through (g);
- (2) The surcharge set forth in § 1.20(i)(2); and
- (3) A statement that the delay in payment of the maintenance fee was unintentional.

35 U.S.C. § 41(c)(1) authorizes the Director to accept a delayed maintenance fee payment within twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) if the delay is shown to have been unintentional, and authorizes the Director to accept a delayed maintenance fee payment at any time if the delay is shown to have been unavoidable. Thus, 35 U.S.C. § 41(c)(1) does not authorize the Director to accept a delayed maintenance fee payment later than twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) unless the delay is shown to have been unavoidable. Since the instant petition was not filed within twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b), the Director cannot accept a delayed maintenance fee payment for the above-identified patent under 37 CFR 1.378(c).

The petition under 37 CFR 1.378(c) is therefore dismissed.

PETITION UNDER 37 CFR 1.378(b)

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

This petition lacks item (1) above.

Petitioner, sole inventor Paul D. Baillargeon (hereinafter "Baillargeon"), states that at the time the patent issued, petitioners' registered patent practitioner, Daniel J. Bourque (hereinafter "Bourque"), was responsible for tracking the maintenance fee and informing Baillargeon when the maintenance fees were required to be paid. Petitioner have shown that Bourque sent letters to petitioner's home address dated July 27, 2004 and September 26, 2005, informing petitioner of the need to pay the first maintenance fee.

Petitioner Baillargeon asserts that he did not receive the letters, however, because he had moved to a new address because of irreconcilable difficulties with his spouse. Petitioner did not file a change of address with the USPS, however, because he believed that his spouse was forwarding all mail to him, and that "he had the expectation of returning to his home upon resolution of his family matters."

Petitioner states, in pertinent part: that

On July 14, 2004, I moved out of my house due to irreconcilable difficulties with my spouse and moved to a room rental in Allenstown, New Hampshire.

My spouse refused to allow me into our home and divorce proceedings were filed on August 25, 2004. My spouse periodically contacted me and gave me my mail that was mostly bills for the house and told me I had no other mail.

I lived in the room rental in Allenstown for almost 16 months and did not contact the United States Post Office to have my mail forwarded during that time, because this was only a temporary residence and I knew I would be able to move back into my house after the divorce settlement or be residing elsewhere.

During the prosecution of this patent I had received all correspondence and updates from Bourque & Associates via email or phone. I have always kept the same email address and was available for correspondence.

After moving to a new permanent address in November, 2005, I directly contacted utility companies to setup

[sic] new accounts and took no further steps to change or forward mail that had been sent to my original home address in Chichester, New Hampshire. Having never conducted any correspondence by regular mail where all prior correspondence and communications had been by email in the past from Bourque & Associates, I felt secure that I could be reached if and when necessary.

After the patent issued, I received no further emails from Bourque and Associates until December 3, 2009 when I initiated contact with them through email to inquire on the status of the patents I held. I received a reply and information that two of my patents were abandoned due to non-payment of maintenance fees.

Petitioner's counsel further states:

Unbeknownst to either Petitioner or Attorney Bourque, Petitioner's spouse was apparently destroying certain of Petitioner's mail and failed to forward any of Attorney Bourque's correspondence to Petitioner. Petitioner's spouse also insisted that there was no other mail for the Petitioner.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".¹

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").² Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.³ In this regard:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of

¹ 35 U.S.C. § 41(c)(1).

² Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

³ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.⁴

A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."⁵ This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."⁶ Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.⁷ Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.⁸ However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.⁹ In view of In re Patent No. 4,409,763, this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

⁴ In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

⁵ Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

⁶ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

⁷ In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

⁸ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

⁹ Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.¹⁰ That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.¹¹

Thus, a grantable petition under 37 CFR 1.378(b) requires a documented showing that the delay was unavoidable. In this regard, statements must be provided from all persons having first-hand knowledge of the delay, setting forth the facts as they know them. As such, if petitioner believes that his ex-spouse received the letters from Bourque, a statement from the ex-spouse must be provided setting forth whether or not she received the letters and what efforts were made by her to forward the letters to petitioner.

Further in this regard, a showing of unavoidable delay requires diligence commensurate with the level of a "reasonably prudent person in relation to their most important business." In this regard, it is not understood why petitioner would not have notified his attorney of his new address upon moving to ensure that any patent related correspondence was mailed by petitioner's counsel to his current address.

While the difficulties petitioner incurred in dealing with the dissolution of his marriage are unfortunate, the showing of record, that petitioner failed to inform his attorney of his current correspondence address, leads to a finding of a lack of diligence, rather than unavoidable delay, on the part of petitioner.

With regard to petitioner's apparent assertion that he expected to receive notification by email, rather than solely by U.S. mail, that the maintenance fee was due, if petitioner has any documentation in which Bourque stated that maintenance fee reminders would be sent by email, or in a manner other than by postal mail, such should be provided with any renewed petition.

¹⁰ Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

¹¹ Id.

Nevertheless, petitioner is reminded that the failure of communication between an applicant and counsel is not unavoidable delay within the meaning of 37 CFR 1.137(a) or 1.378(b).¹² Specifically, delay resulting from a lack of proper communication between a patent holder and a registered representative as to who bore the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 USC 41(c) and 37 CFR 1.378(b).¹³ Moreover, the Office is not the proper forum for resolving a dispute as to the effectiveness of communication between parties regarding the responsibility for paying a maintenance fee.¹⁴

As the showing of record does not rise to the level of unavoidable delay, the petition will be dismissed.

Petitioner is cautioned to avoid submitting personal information in a patent application that may contribute to identity theft. If personal information such as social security numbers, bank account numbers, or credit card numbers are included in documents submitted to the USPTO (other than a check or credit card authorization form PTO-2038 submitted for payment purposes), petitioners should consider redacting such personal information from the documents before submitting them to the USPTO. This type of personal information is never required by the USPTO to support a petition or an application. Petitioner is advised that any information submitted in an application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, information from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The \$400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

¹² In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

¹³ See Ray, at 610, 34 USPQ2d at 1789.

¹⁴ Id.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

The address in the petition is different than the correspondence address. A courtesy copy of this decision is being mailed to the address in the petition. All future correspondence, however, will be mailed solely to the address of record. A change of correspondence address should be filed if the correspondence address needs to be updated.

Telephone inquiries should be directed to the undersigned at 571-272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Cc: DANIELS PATENT LAW, LLC
 43 CENTRE STREET
 CONCORD NH 03301